

### **Remarks**

This is in response to the non-final Office Action mailed on April 13, 2004. Figure 1 has been amended. Claim 7 has been canceled without prejudice or disclaimer. Claim 1 has been amended to incorporate subject matter from claim 7, and claims 2 and 3 have been amended to address informalities. No new matter has been added. Claims 1-6 and 8 remain pending. Reconsideration and allowance are respectfully requested in view of the following remarks.

#### **I. Drawings**

The drawings were object to under 37 CFR 1.83(a) because the drawings failed to show the portable remote terminal recited in the claims. Figure 1 attached at the Appendix hereto has been amended to show portable remote terminals. Entry of Figure 1 and removal of the objection are respectfully requested.

#### **II. Claim Rejections - 35 U.S.C. § 112**

Claim 2 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the rejection states that the specification fails to adequately describe the "half completed model image by a computer graphic" as recited in claim 2. This rejection is respectfully traversed, and the correctness of the rejection is not conceded.

However, in the interest of moving this application into condition for allowance, claim 2 has been amended to remove the noted subject matter. Reconsideration and allowance are therefore respectfully requested.

#### **III. Claim Objections**

Claim 3 was objected to because of an informality. Specifically, claim 3 was objected to because of the recitation "in which sample design is main." Claim 3 has been amended to address this informality. Removal of the objection is therefore respectfully requested.

#### **IV. Claim Rejections - 35 U.S.C. § 102**

Claims 1-3 were rejected under 35 U.S.C. § 102(e) as being anticipated by Laverty et al., U.S. Patent No. 6,381,032. This rejection is respectfully traversed to the extent it is maintained.

Claim 1 has been amended to incorporate subject matter from canceled claim 7. The rejection concedes that Laverty fails to disclose the subject matter of claim 7 incorporated into claim 1. Reconsideration and allowance of claim 1, as well as claims 2 and 3 that depend therefrom, are therefore respectfully requested.

**V. Claim Rejections - 35 U.S.C. § 103**

Claims 4-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Laverty in view of Official Notice. This rejection is respectfully traversed, and reconsideration is respectfully requested in view of the following remarks.

Preliminarily, it is noted that claim 7 has been canceled, and subject matter from claim 7 has been incorporated into claim 1. Specifically, claim 1 recites, among other limitations, an accepted order means for accepting order of design creation for a background design to be displayed on a display screen provided on a portable remote terminal, and a fee collection means for collecting a fee for producing the image data by downloading image data of design creation created according to the ordering to said portable remote terminal by said customer or a fee for distributing an existing design, said system being utilized in an information communication system capable of using said portable remote terminal which can access the Internet.

There are significant advantages with the use of remote portable terminals in the made-to-order system recited in claim 1. For example, the use of remote portable terminals increases the efficiency of made-to-order systems because of the speed at which such systems operate. In addition, such a configuration reduces the risks associated with prior art systems (e.g., the risks associated with canceled orders - see page 2, lines 5-12 of the present application) and increases the geographic area in which customers can communicate with the system.

The rejection concedes that Laverty fails to disclose a portable remote terminal as recited in claim 1. However, Official Notice is apparently taken that it was well known at the time of the invention to conduct business over the Internet using portable devices.

To establish a *prima facie* case of obviousness, three basic criteria must be met: 1) suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings; 2) a reasonable expectation of success; and 3) the references, when combined must teach or suggest

all the claim limitations. See In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991); and MPEP § 2143 *et seq.*

It is respectfully suggested that the rejection has failed to articulate any motivation to combine the disclosure of Lavery with the Official Notice of use of portable devices. The possible sources for motivation to combine references are: (a) the nature of problem being solved; (b) the teaching of the prior art; and (c) the knowledge of one skilled in the art. MPEP § 2143.01.

There is no motivation identified in Lavery or the statement of Official Notice that would suggest it would be desirable to extend the system disclosed by Lavery to include remote portable terminals as recited by claim 1. There is no suggestion that either the prior art or one skilled in the art would have been motivated to combine the system disclosed by Lavery with a remote portable terminal.

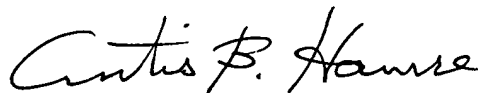
For at least these reasons, it is respectfully suggested that the combination of Lavery with the statement of Office Notice is improper. Reconsideration and allowance of claims 4-6 and 8, which all depend from claim 1, are therefore respectfully requested.

#### **VI. Conclusion**

Favorable reconsideration in the form of a Notice of Allowance is respectfully requested. Please contact the undersigned attorney with any questions regarding this application.

Respectfully submitted,  
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Attachment: Appendix with one replacement sheet